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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/764,770	01/16/2001	Sumit Gupta	0007056-0073/P5380/RJL	7447
7590	05/31/2005		EXAMINER	
B NOEL KIVLIN MEYERTONS HOOD KIVLIN KOWERT & COETZEL P C P O BOX 398 AUSTIN, TX 78767-0398			NGUYEN BA, PAUL H	
			ART UNIT	PAPER NUMBER
			2176	
DATE MAILED: 05/31/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/764,770	GUPTA, SUMIT
	Examiner	Art Unit
	Paul Nguyen-Ba	2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 22 February 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 21-38 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 21-38 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/22/2005</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. This action is responsive to Applicant Amendment, Remarks, and Information Disclosure Statement filed on 2/22/2005.
2. Claims 21-38 are currently pending. Claims 21 and 30 are independent claims.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title; if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 21-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang et al. ('426"), U.S. Patent No. 5,848,426, in view of Mihm et al. ("Mihm"), U.S. Patent No. 5,387,783).

Independent Claim 21

'426 teaches a method (see Abstract) wherein a data file of a first business system (i.e. computer programs) is encoded into a 2-D image code, consisting of format information (see col. 7 lines 55-60), which is printed out to a physical document (col. 3 lines 1-5; col. 4 line 13-14; see

also Figs. 4, 5, 7-10, 12) (compare with “*converting said initial electronic document...physical document...formatting commands*”);

the document in human readable form (i.e. *physical document*) is then scanned and the 2-D machine readable image code is then decoded (*compare with “interpret”*) to recover the format information on a second business system (see col. 4 lines 15-21) (compare with “*transform said physical document into said second electronic document in accordance with said formatting commands*”).

‘426 does not specifically teach a *printer inserting the formatting command into an initial electronic document*. However, ‘426 teaches the preparation of a document with the 2-D formatting commands prior to printing the physical document (col. 6 lines 16-17). Furthermore, Mihm teaches a printing device (“the barcoder”) (see Mihm col. 3 lines 55-58). The printing device (“the barcoder”) generates graphics data for the barcode representation of the Zip Code and inserts the graphics data into the electronic representation of the document (see Mihm Abstract – 2nd to last sentence) purpose of preparing an initial electronic document with bar code Zip Code representations prior to converting the electronic document into physical form.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the teaching of ‘426 with the teachings of Mihm to include a printing device inserting formatting commands into an initial electronic document for the purpose of preparing an initial electronic document with formatting commands prior to converting the document into physical form.

Claims 22-27

‘426 teaches a method for converting a physical document into an electronic document (see Abstract) wherein a data file of a first business system (i.e. computer programs) is encoded into a 2-D image code consisting of format information (i.e. documents format standard) (see col. 7 lines 55-60) including pictorial and textural features extracted from the document (see col. 6 lines 29-32), but does not specifically teach wherein formatting commands are fonts, font sizes, alignment tags, tabs, margins, and table definitions.

However, it was commonly known to those of ordinary skill in the art and would have been obvious at the time the invention was made to a person having ordinary skill in the art that “format information” specifies properties, particularly visible properties, of an object. For example, word processing applications allow you to format text, which involves specifying the font, alignment, margins, and other properties for the purpose of organizing and personalizing the contents of a document for visible display.

Claim 28

‘426 teaches the method wherein said formatting commands are printed on a side of said physical document (see Figs. 7, 8, and 10).

Claim 29

‘426 teaches *placing one or more bar codes into said physical document wherein said bar codes are viewable representations of said formatting commands* (col. 5 lines 42-50; see also Figs. 4 and 5).

Independent Claim 30

With respect to independent claim 30, please refer to the rationale relied upon to reject independent claim 21.

Claim 31

Claim 31 incorporates substantially similar subject matter as claim 22, and is rejected along the same rationale.

Claim 32

Claim 32 incorporates substantially similar subject matter as claim 23, and is rejected along the same rationale.

Claim 33

Claim 33 incorporates substantially similar subject matter as claim 24, and is rejected along the same rationale.

Claim 34

Claim 34 incorporates substantially similar subject matter as claim 25, and is rejected along the same rationale.

Claim 35

Claim 35 incorporates substantially similar subject matter as claim 26, and is rejected along the same rationale.

Claim 36

Claim 36 incorporates substantially similar subject matter as claim 27, and is rejected along the same rationale.

Claim 37

Claim 37 incorporates substantially similar subject matter as claim 28, and is rejected along the same rationale.

Claim 38

Claim 38 incorporates substantially similar subject matter as claim 29, and is rejected along the same rationale.

Response to Arguments

5. Applicant's arguments with respect to claims filed on 2/22/2005 have been considered but are moot in view of the new ground(s) of rejection. The Mihm et al. reference has been added to teach Applicant's newly added limitation "*a printer* inserting..." as discussed above.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Nguyen-Ba whose telephone number is (571) 272-4094. The examiner can normally be reached on 10 am - 6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


JOSEPH FEILD
SUPERVISORY PATENT EXAMINER

PNB